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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,213	01/31/2001	Andre Rosenthal	ALBRE-14	8558

23599 7590 04/16/2003

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EXAMINER

ALLEN, MARIANNE P

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,213

Applicant(s)

ROSENTHAL ET AL.

Examiner

Marianne P. Allen

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/26/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. (See inventors Schaefer, Tchernitsa, Grips, and Schmitz.) See 37 CFR 1.52(c).

In addition, one of the corrections is in pencil (for Reinhold Shaefer) and not in permanent ink, or its equivalent in quality, as required under 37 CFR 1.52(a).

Drawings

The substitute drawings submitted 4/26/02 are acknowledged. However, these drawings are objected to by the examiner. It is noted no Figure 12 or 13 was submitted. It appears that the figure submitted as Figure 11, 11A, 11B, 11C, 11D, and 11E corresponds to originally filed Figure 13 (6 pages) and that Figure 11 (51 pages) and Figure 12 (228 pages) were not provided. In addition, the numbering of the figures no longer corresponds to the numbering present in the specification. Correction is required.

Specification

Submission of the computer readable form (CRF) on 4/26/02 is acknowledged. However, the statement under 37 CFR 1.182(g) is insufficient. There is no statement that the paper copy of the sequence listing and the sequence listing on the CRF submitted are identical. See 37 CFR 1.821(f).

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a nucleic acid, classified in class 536, subclass 23.1.
- II. Claim 16, drawn to a nucleic acid array, classified in class 422, subclass 68.1.
- III. Claims 17, 19, and 22 drawn to a method of diagnosis using a nucleic acid, classified in class 435, subclass 6.
- IV. Claim 18, drawn to a method of producing an agent, classified in class 435, subclass 69.1, for example.
- V. Claim 20-21, drawn to a method of modulating expression by administering a nucleic acid, classified in class 514, subclass 44.
- VI. Claim 23, drawn to a method of administering a polypeptide, classified in class 514, subclass 12.
- VII. Claim 24, drawn to a method of administering antibodies, classified in class 530, subclass 387.1.
- VIII. Claims 25-26, drawn to a method for assaying activity, classified in class 435, subclass 6.

It is noted that claims 18, 20, 21, 23, and 24 are use claims but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. Their dependencies on claims 17, 19, and 22 (previously use claims and now amended) are confusing as they appear to be directed to different methods or the limitations are inconsistent with the independent claim upon which they depend. As such, the groups set forth above reflect the examiner's best understanding of what was intended.

In addition, if Group I or III-VIII is elected, applicant must further elect a single specific nucleic acid sequence (SEQ ID NO.) for examination. Applicant should identify which claims of Group I this nucleic acid sequence corresponds to. If Group II is elected, applicant must further elect a specific combination of nucleic acid sequences on the array for examination.

The products of Groups I and II can be shown to be distinct from each of the methods of Groups III-VIII because they are either not used by the method or can be used in multiple methods. The products of Groups I and II can be shown to be distinct from each other as they differ structurally and functionally. In addition, each of the nucleic acid sequences and each combination of nucleic acid sequences arranged on an array is considered to be an independent invention as none of the nucleic acid sequences disclosed or claimed appears to share a common structure.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and the search, particularly for non-patent literature, required for each Group and sequence is not coextensive with the search for any other Group and sequence, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

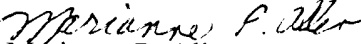
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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 8:30 am - 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
April 16, 2003